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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 99039	
		Application Number 10/829,614	Filed April 22, 2004
		First Named Inventor Paul L. Falkenstein et al.	
		Art Unit 1731	Examiner Q. S. Dehghan
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		 Signature	
<input type="checkbox"/> applicant inventor.		Algahe Ahmad Typed or printed name	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.79(b) is enclosed. (Form PTO/SB/85)			
<input type="checkbox"/> attorney or agent of record. Registration number _____		(202) 404-1557 Telephone number	
<input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. 47,381		January 11, 2007 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of 2 forms are submitted.			

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Falkenstein et al.
Serial Number : 10/829614 Examiner: Dehghan, Q.
Filed : April 22, 2004 Group Art Unit: 1731
For : Fused Array Preform Fabrication of Holey Optical Fibers

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner of Patent and Trademarks
Washington, D.C. 20231

Sir:

For the Pre-Appeal Brief Panel's convenience, a summary of the prosecution history of the above-identified application is as follows:

- 1) In the Office Action dated April 18, 2006, the Examiner asserted a restriction requirement against the pending claims. Accordingly, Applicants withdrew claims 18-20, and requested prosecution of claims 1-17.
- 2) Starting on page 4, paragraph 10 of the Office Action dated June 15, 2006, the Examiner rejects claims 1, 3, 7, 10, and 15 under 35 U.S.C. § 102(e) as being anticipated by Berkey (US2004/0050110), and rejects claims 1, 7-9, and 11-13 under 35 U.S.C. § 103(a) as being unpatentable over Fekety (6,917,741) in view of Large (US 2005/0147366) or in view of Chesnoy (5,792,233).
- 3) Page 8, paragraph 1 of the Response (including amendments) filed on August 9, 2006 points out that Berkey employs a sacrificial rod, which is in contrast to the independent claim which recites the use of a "material having a hollow central portion". Page 8, paragraph 3 points out that Fekety fails to suggest or disclose the concept of "creating a preform having channels therein, by removing a second

structure from the fused element...Moreover, Fekety fails to suggest removing any structure from the preforms.”

- 4) Page 4, paragraph 9 of the Final Office Action dated October 19, 2006, the Examiner rejects claims 18 and 31 under 35 U.S.C. § 103(a) as being obvious over Berkey in view of Siegmund (3,275,428).
- 5) On November 28, 2006, the Examiner conducted a personal interview with the undersigned and one of the inventors Dr. Brian Justus.

The following is a summary of the interview:

a). the Examiner asserted that Berkey discloses all the recited claim limitations except tubules, the Examiner cited Siegmund for the tubules and stated it would be obvious to use the tubules of Siegmund in the method of Berkey to obtain the invention as claimed.

b). Dr. Justus pointed out that the Siegmund tubules are first drawn then the preform is created. Further, if the Siegmund tubules are formed into a preform and then drawn the result will not form a holey fiber, as recited in claims 18 and 31. This was demonstrated by Dr. Justus by showing the Examiner a piece of fiber that he had attempted to make into holey fiber with tubules similar to the Siegmund tubules. Dr. Justus showed how the tubules that are formed into a preform and then drawn were too narrow and collapsed upon themselves. The tubules Dr. Justus used were too narrow to be drawn (similar to the Siegmund tubules) and therefore collapsed on one another, failing to form a holey fiber. Accordingly, the step of “drawing the preform” as recited in claims 18 and 31 cannot be achieved with the Siegmund tubules.

- c). The undersigned then stated that employing the Siegmund tubules within the method of Berkey et al. would render the Berkey method unsatisfactory for its intended purpose, i.e., the method would not make a holey fiber, as recited in claims 18 and 31. Accordingly, under MPEP 2143.01, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”
- d). Despite Dr. Justus’ reasoning and demonstration, the Examiner maintained that the Berkey and Siegmund reference could be combined to produce the invention as claimed in claims 18 and 31.
- 6) Applicants filed a Request for Reconsideration on December 6, 2006, reiterating the substance of the personal interview. An Advisory Action was issued on January 4, 2007 maintaining the rejection.

Accordingly, Applicants respectfully request the Pre-Appeal examining group decide the following issue:

Whether a person of ordinary skill in the art would have been motivated to combine the tubules disclosed in Siegmund in the method disclosed in Berkey to produce the invention as recited in independent claims 18 and 31.

Claim 18 recites, *inter alia*, A method for making a holey fiber, said method comprising:

creating a preform having channels therein, by removing the second structure from the fused element;

drawing the preform at a draw temperature which is below the softening point of the first structure.

Claim 31 recites. *inter alia*, a method for making a holey fiber, said method comprising:

creating a preform by removing the non-glass tubes from the fused element thus forming channels in the fused element; and

drawing the preform at a draw temperature which is near the softening point of the glass rod or tubes to form the holey fiber

As argued in the response dated December 6, 2006, and as discussed in the personal interview on November 28, 2006, one of ordinary skill in the art would find that a device employing the Siegmund tubules in the method disclosed in Berkey would not include creating a preform, and drawing the preform, and thus the combination of Siegmund and Berkey would not disclose a method of making holey fiber as recited in claims 18 and 31. Specifically, as Dr. Justus stated, the diameter of the Siegmund tubules could not be used as tubules in Berkey because the diameter of the tubing would be too narrow to create a preform and draw the preform, as recited in claims 18 and 31. Moreover, the resultant tubule would be too narrow and have a length that is too long to allow for etchant to flow through, such a preform could not be created nor could a preform be drawn, as required by the limitations of claims 18 and 31.

It is critical for the Siegmund tubules to be cut then etched because the tubules have been drawn to a size creating a very long and narrow tubule. The long narrow tubule of Siegmund could not be employed in Berkey to render the device having the claim limitation of "creating the preform... and drawing the preform...". Accordingly, Applicants further submit that the Examiner's finding is clear error.

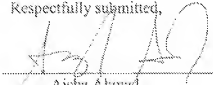
In light of the above discussion, Applicants respectfully submit that the combination of Siegmund and Berkey cannot be combined to disclose all the claim limitations of claims 18-34. Therefore, claims 18-34 are non-obvious over the prior art of record. Further, one of ordinary skill in the art could not modify Berkey in view of Siegmund to

include the claim limitations as recited in claims 18-34. Accordingly, claims 18-34 are in condition for allowance, an indication of which is requested.

If there are any outstanding issues that can be resolved by telephone, please contact the Applicants' attorney Aisha Ahmad at a (202) 404-1557.

Accordingly. Kindly charge any additional fees due or credit overpayment of fees to Deposit Account Number 50-0281.

Respectfully submitted,



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